

REMARKS

The present application was filed on June 29, 2001 with claims 1-39. Claims 1, 21, 25 and 39 are the independent claims.

In the outstanding final Office Action dated February 26, 2008, the Examiner rejected claims 1-39 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,857,020 to Chaar et al. (hereinafter “Chaar”).

Applicants have submitted herewith a Request for Continued Examination under 37 CFR §1.114 along with the fee under 37 CFR §1.17(e). Thus, Applicants respectfully request that prosecution be reopened and that the present amendments be entered. Applicants moreover request reconsideration of the present application in view of the amendments above and the remarks below.

With regard to the §102 rejection, Applicants initially note that MPEP §2131 specifies that a given claim is anticipated “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, MPEP §2131 indicates that the cited reference must show the “identical invention . . . in as complete detail as is contained in the . . . claim,” citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants further note that both Chaar (Reel/Frame 011908/0621) and the present application (Reel/Frame 012247/0426) are currently assigned of record to International Business Machines Corporation (IBM). Furthermore, both Chaar and the claimed invention were subject to an obligation of assignment to IBM at the time the claimed invention was made. Because Chaar qualifies as prior art only under 35 U.S.C. §102(e), Applicant respectfully note that, pursuant to 35 U.S.C. §103(c), Chaar may not be used in any possible rejection under 35 U.S.C. §103(a).

Applicants have amended claims 1, 21, 25 and 39 in this application. Applicants are not conceding in this application that those claims are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

Specifically, independent claims 1, 21, 25 and 39 have been amended without prejudice solely to clarify the scope of the claimed subject matter. As amended, these claims recite that the financial optimization is specified in the electronic contract at the time of construction such that, at the time the financial optimization is to be determined, the electronic contract is accessed to identify a particular financial metric of the financial optimization that is to be computed and to identify an operation for computing the particular financial metric. Support for this amendment may be found in the present specification at, for example, page 13, line 21, through page 14, line 2.

The final Office Action points to column 11 of Chaar in rejecting the financial optimization limitations in independent claim. However, column 11 of Chaar merely mentions that benefits of the Chaar system may help a service provider “manage financial risk” or “capture profit generation opportunities,” however, this in no way teaches or suggests that a financial optimization is actually specified in the electronic contract at the time of construction such that, at the time the financial optimization is to be determined, the electronic contract is [automatically] accessed [by the processor] to identify a particular financial metric of the financial optimization that is to be computed and to identify an operation for computing the particular financial metric, as claimed.

Independent claim 1 also recites a limitation wherein an apparatus comprises at least one processor operative to construct an electronic contract. In an illustrative embodiment described in the present specification at, for example, page 11, lines 22-23, an ecBuilder module constructs the contract based on analyst-specified requirements.

The final Office Action contends that Chaar at column 7, lines 35-50, discloses the above limitation. Applicants respectfully disagree and note that the relied-upon portions of Chaar disclose an e-business SLA management framework which helps a customer and a provider negotiate SLA terms and conditions by providing the customer and the provider an agreeable abstraction of the service management system. Applicants respectfully submit that the teachings of Chaar wherein a framework helps a customer and a provider negotiate SLA terms and conditions fails to meet the limitation of independent claim 1 wherein a processor constructs an electronic contract.

In fact, the relied-upon portion of Chaar specifies that the e-business SLA management framework comprises an established e-business SLA contract. See Chaar at column 7, lines 49-50.

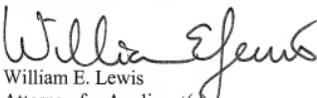
See also Chaar at, for example, column 8, lines 29-32; column 8, lines 47-50; and column 8, lines 64-66.

Independent claims 21, 25 and 39 contain limitations similar to those recited in claim 1 and are thus believed allowable for at least the reasons identified above with regard to claim 1.

Dependent claims 2-20, 22-24 and 26-38 are believed allowable at least by virtue of their dependence from independent claims 1, 21 and 25, respectively. Additionally, one or more of these claims define independently patentable subject matter.

In view of the above, Applicants believe that claims 1-39 are in condition for allowance, and respectfully request withdrawal of the §102(e) rejection.

Respectfully submitted,



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